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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Laura Raus

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Steinfl & Bruno  
301 N Lake Ave Ste 810  
Pasadena, CA 91101

EXAMINER

WAGGLE, JR, LARRY E

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,721	<b>Applicant(s)</b> RAUS, LAURA	
	<b>Examiner</b> Larry E. Waggle, Jr	<b>Art Unit</b> 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 24, 26-30, 32, 34-35 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 27-28, 30, 32, 34 and 40-45 is/are rejected.
- 7) ☒ Claim(s) 24, 26, 29, 35 and 46-49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 27-28, 30, 32, 34 and 40-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourne (US Patent 2,948,174) in view of Garrison (US Publication 2004/0006335).

Bourne discloses a device (Figure 1) comprising a pair of side-by-side blades (38 and 42) slidably coupled (via 36) so that respective distal ends thereof be closable, the one against the other; propelling means (i.e. hydraulic) connected to a slidable blade (42) of the pair comprising a piston (i.e. end comprising 94), a stem (92 and 96) and an intake (89); operation means (62; i.e. trigger); a main body (40) housing the propelling means comprising a portion (i.e. end comprising operation means) handled by a user, wherein the piston is coupled to the slidable blade by interposition of a motion transmission member (98; i.e. lever) rotatably connected at opposed ends (i.e. ends of 97 and 99) to the slidable blade and to the stem of the piston (via 96), the lever being further connected to a chassis (22; i.e. via 102) of the device, the slidable blade is removably connectible (i.e. by the removal of 48) to the propelling means, the slidable blade automatically returns to a resting position (i.e. as shown in Figure 2) when the user releases the operation means and a screw (86; i.e. supply valve) acts as a means

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for adjusting the closing force of the blades, a means for adjusting the relative sliding speed of the blades, and a means for inhibiting operation of the propelling means by being adjustable from any one of numerous positions between fully closed (i.e. tightened) to fully open (i.e. loose) to adjust the flow and therefor pressure of the hydraulic fluid (F) (Figures 1-7 and column 2, line 52 – column 6, line 51).

Bourne discloses the claimed invention except for the propelling means being pneumatic propelling means. Garrison teaches a surgical device (10) comprising a member (16) that reciprocates relative to another member (20), wherein the reciprocating motion is controlled via either a pneumatic pump and motor assembly or a hydraulic pump and motor assembly which are taught as being used interchangeably (paragraph 0022). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Bourne with the use of a pneumatic propelling means in view of Garrison in order to provide an alternative means for controlling the sliding action of the blade that is reasonably pertinent to the particular problem with which the device of Bourne is concerned.

With regard to the statements of intended use and other functional statements, such as “for” and “apt,” they do not impose any structural limitations on the claims distinguishable over Bourne in view of Garrison which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v.*

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Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

***Allowable Subject Matter***

Claims 24, 26, 29, 35 and 46-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments, see pages 2-3, filed 15 April 2010, with respect to the rejection(s) of claim(s) 1, 24, 29, 35, 47 and 49 under 35 U.S.C. 103(a) as being unpatentable over Bent in view of Bourne further in view of Vilsmeier and De Satnick et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments, see pages 1-2, filed 15 April 2010, with respect to the rejection(s) of claim(s) 1, 27-28, 30, 32, 34 and 40-45 under 35 U.S.C. 103(a) as being unpatentable over Bourne in view of Garrison have been fully considered but they are not persuasive.

In response to the applicant's arguments that the device of Bourne is different from a "surgical device apt to the removal of bone, cartilaginous and the like tissues during surgery," the preamble does not impose any structural limitations on the claims distinguishable over the invention of Bourne which is capable of being used as claimed

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if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. The device of Bourne is capable of being used to remove tissue, if one so chooses. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The applicant alludes to the fact that Bourne is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art reference is reasonably pertinent to the particular problem with respect to the particular structure required to slidingly move a pair of blades with respect to each other.

In response to the applicant's arguments that the Bourne discloses "jaws not blades," [www.dictionary.com](http://www.dictionary.com) defines a blade as a thin, flat part of something. The applicant has not claimed the function of the blade; therefore, the blades of the current invention are not patentable distinct over the blades of Bourne.

In response to the applicant's arguments that the blades of Bourne are not "slidably coupled" because that do not "slide one over/on the side of the other," it is noted that the features upon which applicant relies (i.e., the exact orientation of the sliding action of the blades) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the applicant's arguments that the ends of the "motion transmission member" of Bourne are not "rotatably connected" to the blade and the stem of the piston, end 99 is indeed rotatably connected to blade 42 via 100 not 44 as the applicant asserted. Further, [www.dictionary.com](http://www.dictionary.com) defines connected as united, joined or linked. No matter the degree, end 98 is indeed rotatably connected (i.e. as it slides along 96) to the stem of the piston.

In response to the applicant's arguments that the "motion transmission member" of Bourne is not connected to a "central portion" of the chassis, the applicant has not defined the location of the "central portion." For example, the "motion transmission member" is indeed connected to a "central portion" of the distal end of the chassis.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. E. W./  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775